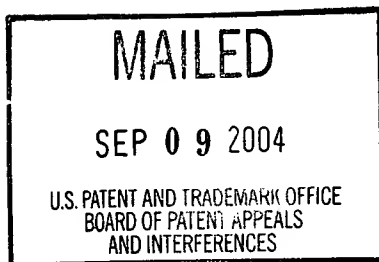


The opinion in support of the decision being entered today was not written
for publication and is not binding precedent of the Board.

Paper No. 40

UNITED STATES PATENT AND TRADEMARK OFFICE

**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**



Ex parte MARTIN KELLY JONES

Appeal No. 2004-0746
Application No. 09/163,588

ON BRIEF

Before HAIRSTON, McQUADE, and NASE, Administrative Patent Judges.
NASE, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 1 to 11,
13, 14, 16 to 23, 27 to 32, 35 to 39 and 41 to 55, which are all of the claims pending in
this application.

We AFFIRM.

BACKGROUND

The appellant's invention generally relates to data communications and information systems and, more particularly, to automated activation system and method for efficiently activating a vehicle travel monitoring system (specification, p. 2). A copy of the claims under appeal is set forth in the appendix to the appellant's brief.

Claims 1 to 11, 13, 14, 16 to 23, 27 to 32, 35 to 39 and 41 to 55 stand provisionally rejected under the judicially created doctrine of double patenting over claims 1-30 of copending Application No. 09/395,497.¹

Claims 1 to 11, 13, 14, 16 to 23, 27 to 32, 35 to 39 and 41 to 55 stand provisionally rejected under the judicially created doctrine of double patenting over claims 1-36 of copending Application No. 09/163,958.²

Claims 1 to 11, 13, 14, 16 to 23, 27 to 32, 35 to 39 and 41 to 55 stand provisionally rejected under the judicially created doctrine of double patenting over claims 1-21 and 23-49 of copending Application No. 08/852,119.³

¹ Application No. 09/395,497 issued as U.S. Patent No. 6,363,323 on March 26, 2002.

² Application No. 09/163,958 issued as U.S. Patent No. 6,278,936 on August 21, 2001.

³ Application No. 08/852,119 issued as U.S. Patent No. 6,748,318 on June 8, 2004.

Claims 1 to 11, 13, 14, 16 to 23, 27 to 32, 35 to 39 and 41 to 55 stand rejected under the judicially created doctrine of double patenting over claims 1-16 of U. S. Patent No. 5,623,260.

Claims 1 to 11, 13, 14, 16 to 23, 27 to 32, 35 to 39 and 41 to 55 stand rejected under the judicially created doctrine of double patenting over claims 1-15 of U. S. Patent No. 5,657,010.

Claims 1 to 11, 13, 14, 16 to 23, 27 to 32, 35 to 39 and 41 to 55 stand rejected under the judicially created doctrine of double patenting over claims 1-80 of U. S. Patent No. 5,668,543.

Claims 1 to 11, 13, 14, 16 to 23, 27 to 32, 35 to 39 and 41 to 55 stand rejected under 35 U.S.C. § 103 as being unpatentable over U.S. Patent No. 5,648,770 to Ross in view of U.S. Patent No. 5,168,451 to Bolger.

Rather than reiterate the conflicting viewpoints advanced by the examiner and the appellant regarding the above-noted rejections, we make reference to the final rejection (Paper No. 20, mailed July 26, 2001) and the answer (Paper No. 23, mailed March 12, 2002) for the examiner's complete reasoning in support of the rejections, and

to the brief (Paper No. 22, filed January 23, 2002) and reply brief (Paper No. 24, filed May 13, 2002) for the appellant's arguments thereagainst.

OPINION

In reaching our decision in this appeal, we have given careful consideration to the appellant's specification and claims, to the applied patents, and to the respective positions articulated by the appellant and the examiner. As a consequence of our review, we make the determinations which follow.

The six rejections based upon the judicially created doctrine of double patenting

We sustain the six rejections of claims 1 to 11, 13, 14, 16 to 23, 27 to 32, 35 to 39 and 41 to 55 under the judicially created doctrine of double patenting.

The appellant argues (brief, p. 35; reply brief, p. 5) that the rejections based on the judicially created doctrine of double patenting are not justified for the present application. The appellant believes a double patenting rejection is improper, since any patent issued from the present application will have a term that will not exceed any of the terms of the patents cited by the Examiner. Although the Examiner asserts that "possible harassment by multiple assignees" is a sufficient justification for a double patenting rejection (see page 8 of answer), the appellant asserts that the possibility of

harassment is not a sufficient ground to uphold a double patenting rejection citing to In re Jentoft, 392 F.2d 633, 157 USPQ 363 (CCPA 1968).

In our view, the rejections based on the judicially created doctrine of double patenting are justified for the present application even if any patent issued from the present application would have a term that will not exceed any of the terms of the applied patents. In that regard, the amendment to 37 CFR § 1.321, effective April 30, 1971, provided that:

A terminal disclaimer, when filed in an application to obviate a double patenting rejection, must include a provision that any patent granted on that application shall be enforceable only for and during such period that said patent is commonly owned with the application or patent which formed the basis for the rejection.

This alienation restriction clause⁴ was upheld by the court in In re Van Ornum, 686 F.2d 937, 214 USPQ 761 (CCPA 1982) effectively overruling the aspect of Jentoft the appellant relies upon to overcome the six rejections based on the judicially created doctrine of double patenting.

For the reasons set forth above, the six decisions of the examiner to reject claims 1 to 11, 13, 14, 16 to 23, 27 to 32, 35 to 39 and 41 to 55 under the judicially created doctrine of double patenting are affirmed.

⁴ The alienation restriction clause is presently set forth in 37 CFR § 1.321(c)(3).

The obviousness rejection

We will not sustain the rejection of claims 1 to 11, 13, 14, 16 to 23, 27 to 32, 35 to 39 and 41 to 55 under 35 U.S.C. § 103 as being unpatentable over Ross in view of Bolger.

The basis for this rejection (final rejection, pp. 4-6) is as follows:

Ross '770 discloses an apparatus and method of notifying a party of a pending delivery or pickup. A mobile receiver or carrier is equipped with a satellite receiver, a controller and a communicator. The position of the vehicle is determined based on positioning data or signals. The controller compares the current vehicle location or position to the location in the mapped area. The communicator then communicates with the user to notify user. As shown in figure 1, there are provided controllers (10 and 21), a video screens or computer displays (14 and 26). Ross '770 also discloses a storage device for storing travel data related to the vehicle. The storage device is mounted on the vehicle located at a remote location. There is also provided a communications device or apparatus for transmitting a message to a controller located at another remote location. The received or transmitted message is indicative of the status (proximity) of the vehicle. As disclosed in column 2, there is provided an analyzer for evaluating the positioning signals to determine the position of the carrier, the position of the carrier is compared with a predetermined location. Also, a time interval is computed, and when the time interval is less than a predetermined time interval, a signal is communication to provide reasonable advance notice. See column 2. Also, a message or notification is forwarded to user via a telephone associated therewith. See columns 5 and 6. As explained, more specifically in the claim section, Ross discloses a voice generator for generating or producing an audible message to notify the party. Ross discloses the time period, and the predetermined distance as the data representative of the proximity of the vehicle. In column 3, Ross '770 discloses the cellular network as a communications device. Further in column 3, Ross '700 discloses the vehicle indicator (identification) and the location indicator. Still in column 3, Ross '770 discloses the communication interface as being telephone interface devices. As an alternate embodiment of the Ross patent, the vehicle can bus a bus and the location indicator is a bus stop. See column 6. However, Ross '770 does not

specifically teach that the user requests is for a specific or particular vehicle, i.e., the request identifying one of the vehicles and a location. Bolger, on the other hand, discloses a user responsive transit system, wherein a user requests information about a specific vehicle of a plurality of fleet vehicles. Based on the user request, a central dispatch controller accesses a database and receives information about the requested vehicle. As shown in figure 7, there are provided a request terminal location (95), a destination location (96) coupled to a service request. As set forth in the specification, the system according to Bolger activates in response to service requests from users. See for example column 3. Thus, it would have been obvious to one skilled in the art at the time of the invention to be motivated to modify the teachings of Ross by incorporating the features from the user responsive transit system of Bolger because such modification will improve "flexibility and efficiency" of the system.

The appellant argues (brief, pp. 20-28) that the subject matter defined in the independent claims under appeal (i.e., claims 1, 13, 23, 31, 39, 45, 49 and 53) is not suggested by the combined teachings of Ross and Bolger.⁵ We agree.

While the examiner is correct that Bolger discloses a user responsive transit system, the examiner is not correct that Bolger teaches that a user requests information about a specific vehicle of a plurality of fleet vehicles. Instead, Bolger teaches that a user/passenger transmits a service request to a central dispatch controller that receives the request and automatically dispatches the most efficient vehicle to service the request. As such, Bolger would not have made it obvious at the time the invention

⁵ The test for obviousness is what the combined teachings of the references would have suggested to one of ordinary skill in the art. See In re Young, 927 F.2d 588, 591, 18 USPQ2d 1089, 1091 (Fed. Cir. 1991) and In re Keller, 642 F.2d 413, 425, 208 USPQ 871, 881 (CCPA 1981).

was made to a person of ordinary skill in the art to have modified Ross so as to arrive at the claimed subject matter (i.e., that the activation request by the user include a vehicle indicator and a location indicator).

In our view, the only suggestion for modifying Ross in the manner proposed by the examiner to arrive at the claimed subject matter stems from hindsight knowledge derived from the appellant's own disclosure. The use of such hindsight knowledge to support an obviousness rejection under 35 U.S.C. § 103 is, of course, impermissible. See, for example, W. L. Gore and Assocs., Inc. v. Garlock, Inc., 721 F.2d 1540, 1553, 220 USPQ 303, 312-13 (Fed. Cir. 1983), cert. denied, 469 U.S. 851 (1984).

For the reasons set forth above, the decision of the examiner to reject claims 1 to 11, 13, 14, 16 to 23, 27 to 32, 35 to 39 and 41 to 55 under 35 U.S.C. § 103 as being unpatentable over Ross in view of Bolger is reversed.

CONCLUSION

To summarize, the decision of the examiner to reject claims 1 to 11, 13, 14, 16 to 23, 27 to 32, 35 to 39 and 41 to 55 under the judicially created doctrine of double patenting over claims 1-30 of copending Application No. 09/395,497 is affirmed; the decision of the examiner to reject claims 1 to 11, 13, 14, 16 to 23, 27 to 32, 35 to 39

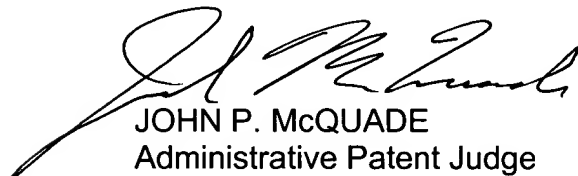
and 41 to 55 under the judicially created doctrine of double patenting over claims 1-36 of copending Application No. 09/163,958 is affirmed; the decision of the examiner to reject claims 1 to 11, 13, 14, 16 to 23, 27 to 32, 35 to 39 and 41 to 55 under the judicially created doctrine of double patenting over claims 1-21 and 23-49 of copending Application No. 08/852,119 is affirmed; the decision of the examiner to reject claims 1 to 11, 13, 14, 16 to 23, 27 to 32, 35 to 39 and 41 to 55 under the judicially created doctrine of double patenting over claims 1-16 of U. S. Patent No. 5,623,260 is affirmed; the decision of the examiner to reject claims 1 to 11, 13, 14, 16 to 23, 27 to 32, 35 to 39 and 41 to 55 under the judicially created doctrine of double patenting over claims 1-15 of U. S. Patent No. 5,657,010 is affirmed; the decision of the examiner to reject claims 1 to 11, 13, 14, 16 to 23, 27 to 32, 35 to 39 and 41 to 55 under the judicially created doctrine of double patenting over claims 1-80 of U. S. Patent No. 5,668,543 is affirmed; and the decision of the examiner to reject claims 1 to 11, 13, 14, 16 to 23, 27 to 32, 35 to 39 and 41 to 55 under 35 U.S.C. § 103 as being unpatentable over Ross in view of Bolger is reversed.


Since at least one rejection of each of the appealed claims has been affirmed, the decision of the examiner is affirmed.

No time period for taking any subsequent action in connection with this appeal
may be extended under 37 CFR § 1.136(a).

AFFIRMED


KENNETH W. HAIRSTON
Administrative Patent Judge


JOHN P. McQUADE
Administrative Patent Judge


JEFFREY V. NASE
Administrative Patent Judge

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